REMARKS

Favorable reconsideration of this application, a presently amended and in light of the following discussion, is respectfully requested.

Claims 1-15 are currently pending. Claims 1, 3, 5, 7, 9, and 11 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1 and 3 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 5,544,289 to Motoyama et al. (hereinafter "the '289 patent") in view of U.S. Patent No. 5,935,262 to Barrett et al. (hereinafter "the '262 patent"); Claims 1-3, 5-7, 9-11, and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,897,236 to Hashimoto et al. (hereinafter "the '236 patent") in view of U.S. Patent No. 5,184,179 to Tarr et al. (hereinafter "the '179 patent"); Claims 4, 8, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '236 and '179 patents, further in view of U.S. Patent No. 5,901,286 to Danknick et al. (hereinafter "the '286 patent"); and Claims 1, 5, and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '262 patent.

Amended Claim 1 is directed to a method of monitoring an image handling device communicatively coupled to a network, comprising: (1) obtaining, by a first monitoring device over the network, device information of the image handling device, the device information including status information obtained from sensors of the image handling device and a device identification of the image handling device; (2) storing, by first monitoring device, the obtained device information; (3) processing the stored device information by the first monitoring device to generate a period usage report for the image handling device, wherein the period usage report is based on the status information obtained over a

7

predetermined period of time; (4) transmitting the usage report over the network from the

first monitoring device to a second monitoring device; and (5) receiving the usage report by

the second monitoring device. Further, amended Claim 1 clarifies that the first monitoring

device is remote from the image handling device and the first monitoring device is the first

device to obtain the device information from the image handling device. The changes to

Claim 1 are supported by the originally filed specification and do not add new matter.[1]

Applicants respectfully submit that the double-patenting rejection of Claims 1 and 3 is

rendered moot by the present amendment to Claim 1.

Claim 1 of the '289 patent is directed to a method, comprising: (1) storing semi-static

data in a business office device, the semi-static state data including data which may change

infrequently over a life of the business office device; (2) initiating communication between

the business office device and a computer, by the business office device; (3) transmitting the

semi-static data from the business office device to the computer; and (4) receiving the semi-

static data by the computer. However, Applicants respectfully submit that '289 Claim 1 fails

to disclose obtaining status information from sensors of an image handling device and a

device identification of an image handling device, as recited in amended Claim 1. '289

Claim 1 fails to disclose the sensors and device identification limitations. Further, '289

Claim 1 fails to disclose processing stored device information by the first monitoring device

to generate a usage report of the image handling device, wherein the period usage report is

based on the status information obtained over a predetermined period of time. Further, '289

Claim 1 fails to disclose transmitting the usage report over a network from the first

monitoring device to a second monitoring device, and also fails to disclose that the first

monitoring device is remote from the image handling device and the first monitoring device

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[1] See, e.g., Figures 11 and 25-28 and the discussion related thereto in the specification.

is the first device to obtain the device information from the image handling device, as recited in amended Claim 1.

As discussed in more detail below, the '262 patent is directed to a system in which a network expansion device (NED 1001) is directly connected to a printer. Thus, the '262 patent fails to disclose a first monitoring device that is remote from an image handling device, <u>wherein the first monitoring device is the first device to obtain the device information from the image handling device</u>, as recited in amended Claim 1. Moreover, the '262 patent fails to disclose processing the stored device information by a first monitoring device to generate a period usage report for the image handling device, wherein the period usage report is based on status information obtained over a predetermined period of time, as recited in amended Claim 1.

Accordingly, no matter how the teachings of the '289 and '262 patents are combined, the combination does not teach or suggest all of the limitations recited in amended Claim 1. In particular, the suggested combination does not teach or suggest a first monitoring device that is remote from an image handling device, wherein the first monitoring device is the first device to obtain device information from an image handling device. In this regard, Applicants note that the outstanding Office Action claims that "the difference between the [present] application and the ['289] patent is that in the application a <u>determination</u> as to whether to transfer to the second computer is made, in instant application a report is periodically generated for transmission to a computer,"[2] and proceeds to rely on the '262 patent to remedy the deficiency. However, Applicants respectfully submit that such a "determination" is not recited in either '289 Claim 1 or in Claim 1 of the present application. Thus, Applicants fail to understand why the Examiner states that this is a difference (let alone the only difference) between the claims in the '289 patent and in the present application.

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[2] Pages 2-3 of the outstanding Office Action. Emphasis added.

Moreover, as discussed above, Applicants respectfully submit that there are many differences

between '289 Claim 1 and Claim 1 of the present application. For example, the status, device

identification, storing, processing, transmitting, receiving, and remote limitations are not

recited in '289 Claim 1. Accordingly, for the reasons stated above, Applicants respectfully

traverse the obviousness-type double patenting rejection of Claims 1 and 3.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a) based on the '236 and

'179 patents, the Office Action asserts that the '236 patent discloses everything in Claim 1

with the exception of "where the network device and the first computer communicate over a

network,"[3] and relies on the '179 patent to remedy that deficiency.

The '236 patent is directed to a communication control device connected between an

image forming apparatus and a communication line that connects the image forming

apparatus to a host machine. The '236 patent discloses that "the control device 18 is inserted

in the user's existing communication line."[4] However, as admitted in the Office Action, the

'236 patent fails to disclose obtaining, by a first computer over the network, device

information, the device information including status information obtained from sensors of the

device and a device identification of the device. Accordingly, Applicants submit that the

'236 patent fails to disclose the obtaining step recited in amended Claim 1. Further,

Applicants respectfully submit that the '236 patent fails to disclose processing stored device

information by the first monitoring device to generate the period usage report for the image

handling device, wherein the period usage report is based on the status information obtained

over a predetermined period of time, as recited in amended Claim 1. Rather, the '236 patent

merely discloses that a total counter value data received from an image forming device can be

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[3] See page 4 of the outstanding Office Action.
[4] '236 patent, col. 6, lines 7-9.

stored in the communication control device and then sent to the host machine when requested

or at a particular time.

The '179 patent is directed to a system for monitoring a variable output paper

processing device. As shown in Figures. 1 and 2, the '179 patent discloses a computer

control 16, which includes a monitoring CPU 24 and a counter detector 18, which are

connected directly to a copier. Further, the '179 patent discloses that the counter detector 18

counts the number of pages processed by the copier and transmits that count to the computer

control 16, which stores the information until a predetermined time and then transmits that

information to a billing center at predetermined intervals. As shown in Figure 1, the count

detector is part of the computer control 16. Thus, the '179 patent discloses that the computer

control 16 is the first monitoring device to obtain the device information from the copier.

However, Applicants respectfully submit that the '179 patent fails to disclose that the

computer control 16 is configured to obtain, over the network, device information of the

image handling device, wherein the first monitoring device (in this case the computer control

16) is remote from the image handling device, and that the first monitoring device (i.e., the

computer control 16) is the first device to obtain the device information from the image

handling device, as recited in amended Claim 1. Moreover, regarding Figure 2, the '179

patent discloses that copiers and associated computer control devices 16 may be connected in

a local area network using local area network transceivers 42 connected to a computer control

device 46, which in turn is connected to a modem 14 and a telephone line. In this regard, the

'179 patent discloses that "control 46 polls each copier station at predetermined intervals and

stores information received from each local computer control 16 and transmits that

information at a predetermined time through modem 14 to the billing center."[5] However,

Applicants submit that the computer control 46 disclosed by the '179 patent is not the first

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[5] See '179 patent, col. 9, lines 37-41.

monitoring device to obtain the device information from the copier, as required by amended

Claim 1. In this regard, Applicants note that in the response to Applicants' previous

arguments, the Examiner cites the following statement in the '179 patent at column 65 to

column 10, line 2: "by providing a local area network between the computer control circuit

and the copier, it becomes possible to monitor a plurality of copiers while tying up only a

single external telephone line saving telephone time and telephone space."[6] Initially,

Applicants note that the paragraph from which at sentence is taken is directed to computer

control 46. Thus, Applicants respectfully submit that the "computer control circuit" recited

in the above sentence refers to computer control 46, not computer control 16, as asserted in

the Office Action. In this regard, Applicants note that the Examiner has incorrectly quoted

the sentence by inserting the number 16 after the words "computer control."[7] Moreover,

Applicants note that none of the figures in the '179 patent support an assertion that a local

area network is provided between the copier and the computer control 16, as suggested by the

Office Action. Rather, Figure 2 shows that the computer control 16 receives counts from the

copier via the count detector 18 and is connected to the interface circuit 20. However, Figure

2 does support Applicants' assertion that the '179 patent discloses a local area network is

provided between the computer control 46 and the copiers.

Accordingly, no matter how the teachings of the '236 and the '179 patents are

combined, the combination does not teach or suggest the step of obtaining, by a first

monitoring device over the network, device information of an image handling device,

wherein the first monitoring device is remote from the image handling device, and the first

monitoring device is the first device to obtain the device information from the image handling

device, as recited in amended Claim 1. Accordingly, Applicants respectfully submit that the

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[6] Emphasis added.
[7] See page 6 of the outstanding Office Action.

rejection of Claim 1 (and dependent Claims 2 and 3) as being unpatentable over the '236 and '179 patents is rendered moot by the present amendment to Claim 1.

Independent Claims 5 and 9 recite limitations analogous to the limitations recited in amended Claim 1. Moreover, Claims 5 and 9 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 5 and 9 (and all similarly rejected dependent claims) are rendered moot by the present amendment to Claims 5 and 9.

Regarding the rejection of dependent Claims 4, 8, and 12 under 35 U.S.C. § 103(a), Applicants respectfully submit that the '286 patent fails to remedy the deficiencies of the '236 and '179 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejections of Claims 4, 8, and 12 are rendered moot by the present amendment to independent Claims 1, 5, and 9.

Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. § 103 as being unpatentable over the '262 patent is rendered moot by the present amendment to Claim 1.

The '262 patent is directed to a network device that interfaces between a local area network and an image forming apparatus. As shown in Figure 1, the '262 patent discloses a printer 102 that has a network expansion device (NED) 1001 directly attached to the printer 102. As show in Figure 6, the NED includes an 8-bit microprocessor 173, Flash EPROM 174, and DRAM 175. Further, the '262 patent discloses that the NED 1001 can transfer information about the printer status to a local area network. However, Applicants respectfully submit that the '262 patent fails to disclose the step of obtaining, by a first monitoring device over the network, device information of an image handling device, the device information including status information obtained from sensors of the image handling

device and a device identification of the image handling device, wherein the <u>first monitoring device is remote from the image handling device and the first monitoring device is the first device to obtain the device information from the image handling device</u>, as recited in amended Claim 1. The '262 patent fails to disclose that the NED 1001 is remote from the printer 102 and obtains information from the printer over the network, as required by amended Claim 1. Rather, the '262 patent discloses a system in which a network expansion device is directly connected to the image forming device. In this regard, Applicants note that the Office Action refers to column 1, lines 51-65 as disclosing that the first computer is remote from the network device. However, Applicants note that that passage from the '262 patent is directed to a description of the related art and merely discloses that a second computer can be remote from the first computer, which in this case is directly connected to a peripheral device such as a printer. This description is consistent with that shown in Figure 1 of the '262 patent, in which the network device 1001 is directly connected to the printer.

As set forth in the Response to Arguments section on page 7 of the outstanding Office Action, the Examiner is apparently taking the position that the first computer recited in the previous version of Claim 1 is not disclosed by the NED 1001, but rather by the "computer" that receives the log file from the NED, as recited in column 1, lines 52-53 of the '262 patent. However, under this interpretation, Applicants respectfully submit that such a computer is not the first device to obtain the device information from the image handling device, as required by amended Claim 1. Rather, the NED 1001 disclosed by the '262 patent is the first device to obtain the device information from the printer disclosed in the '262 patent. Alternatively, if the NED 1001 is to be interpreted as the claimed first monitoring device, Applicants respectfully submit that the '262 patent fails to disclose that the NED 1001 obtains the device information <u>over the network</u> and that the NED 1001 is <u>remote</u> from the printer disclosed by the '262 patent. Thus, under either interpretation, Applicants respectfully submit that the

14

'262 patent fails to disclose the first monitoring device recited in amended Claim 1.

Accordingly, for the reasons stated above, Applicants respectfully submit that Claim 1
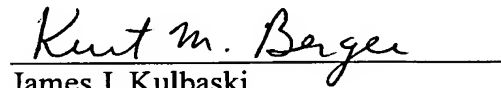
patentably defines over the '262 patent.

Claims 5 and 9 recite limitations analogous to the limitations recited in amended

Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1,

Applicants respectfully submit that the rejections of Claims 5 and 9 as being unpatentable

over the '262 patent are rendered moot by the present amendment to Claims 5 and 9.

Thus, it is respectfully submitted that independent Claims 1, 5, and 9 (and all

associated dependent claims) patentably define over any proper combination of the '236,

'179, '262, '286, and '289 patents.

Consequently, in view of the present amendment and in light of the above discussion,

the outstanding grounds for rejection are believed to have been overcome. The application as

amended herewith is believed to be in condition for formal allowance. An early and

favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

James J. Kulbaski
Registration No. 34,648
Attorney of Record
Kurt M. Berger, Ph.D.
Registration No. 51,461

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)

JJK/KMB/law/fbl
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15